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In re Application of	:	DECISION ON
David WOESSNER	:	
PCT No.: PCT/US03/00977	:	
Application No.: 10/088,181	:	PETITION UNDER
Int. Filing Date: 14 January 2003	:	
Priority Date: 15 January 2002	:	
Attorney's Docket No.: 60158-272	:	37 CFR 1.47(b)
For: HOUSE IN TUBE FORMING ASSEMBLY	:	
AND PROCESS	:	

This decision is in response to applicant's "PETITION UNDER 37 CFR 1.47(b)" submitted on 12 April 2005 that seeks the acceptance of the application without the signature of the inventor David WOESSNER.

BACKGROUND

On 14 January 2003, applicant filed international application PCT/US03/00977, which claimed priority of an earlier application filed 15 January 2002.

On 14 July 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). However, no executed declaration or oath was submitted at such time.

On 09 February 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 indicating that "the oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. The notification set two months from the date of this notice or 22 months from the priority date for the application, whichever is later. Failure to properly respond will result in abandonment."

In an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), applicant filed on 11 December 2002 a petition under 37 CFR 1.47(b).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Applicant has satisfied item (3), and but not items (1)-(2), and (4) - (6) thus not completing the requirements under 37 CFR 1.47(b).

Applicant has not satisfied item (1) since the petition fee has not been provided.

Regarding requirement (2), applicant has not provided sufficient evidence that Mrs. Woessner, the legal representative of the deceased inventor David Woessner, refused to sign the declaration. Ms. Amy Spaulding has not sufficiently demonstrated that a copy of the application papers were presented to the non-signing legal representative of the deceased inventor since the emails with the attachments were directed to David and not to Catherine Woessner. Also, applicant has not stated that the application papers (specification, including claims, drawings, and oath or declaration) were sent to the Mr. Woessner's legal representative and that the legal representative refused to sign the required papers as stipulated under MPEP 409.03(d) after reviewing all the application papers.

In addition, it is not unclear if Mrs. Woessner refuses to sign since in the email dated March 15, 2005 she indicates that she needs to get a lawyer and the email dated April 5, 2005 she refers that she is being "pressured into something that it is not right." These actions do not yet contemplate a refusal on her part because she appears to be considering her options. She should be allowed a certain time-period to make her decision. In fact, the petition was filed on April 12, 2005 a week after receiving her last email which not enough time to construe her actions as a refusal to sign the required papers.

Regarding item (3), applicant has stated the last known address of the Mrs. Woessner:

5641 Spencer Road
Mount Sterling, KY
40353, United States

Regarding item (4) a declaration has not been provided executed by an appropriate officer of company on behalf of the non-signing legal representative of the deceased inventor.

Regarding item (6) applicant has not presented an adequate showing that the granting of this petition is necessary to preserve the rights of the parties or to prevent irreparable damage.

Regarding item (5) applicant has not submitted proof that applicant has sufficient proprietary interest in the application. Mr. Zakrzewski's statement is not sufficient without corroborating evidence from an employment agreement with a written agreement to assign the invention since there is no copy of a signed assignment (signed assignment by inventor Mr. David Woessner) provided with this petition. Note MPEP 409.03(f)

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant prior to the date the application is deposited in the Patent and Trademark Office.

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by affidavit or declaration that those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(b) at this time.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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